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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,076	12/31/2001	David Kaufman	KCC4803 (K-C No. 16,436)	9166

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SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

RHODE JR, ROBERT E

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,076

Applicant(s)

KAUFMAN ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The office action of 11/06/2002 rejected claims 1 - 33.

Applicant amendment of 02/06/2003 amended claims 1, 3, 4, 10, 11, 17 - 20, 24, 28 and added new claims 34 - 40. Moreover, applicant traversed rejections of claims 1 - 33 as well as the 35 USC 101 rejections of claims 1 - 13, 15, 16 and 28 - 33. Additionally, applicant amended claims 19 and 20 as depend from claim 18, which overcame the 35 USC 112 rejection.

Currently, claims 1 - 40 are pending.

Response to Arguments

Applicant traverses and claims that the 35 USC 101 rejection does not apply. The applicant argues that the method claims do recite statutory subject matter because they relate to technology and that 35 USC 101 does not require the recitation of technology.

All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." In re Musgrave, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). However, the applicant's claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts.

Applicant's arguments with respect to claims 1 – 33 art rejections have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 10 and 36, 11 – 15 and 37, 28 – 32 and 40 as well as claims 34 - 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For example in Claim 1, the applicant has not recited the use of any technology and therefore the method can be performed manually.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5 - 7, 10 – 13, 15 – 21, 23 – 29 and 31 - 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Who Wants to Market a Millionaire?”; Rosenspan, Alan; Direct Marketing; March 2001; page 45 (hereafter referred to as Direct Marketing) in view of Forseth (US Patent Application Publication 2002/0004749A).

Regarding claim 1 and related claims 11, 17, 24, 28 and 34, Direct Marketing discloses and teaches a method and system in which a supplier provides to a consumer an absorbent paper product (Page 2, lines 42 – 44). In addition and regarding claims 12, and 32, Direct Marketing teaches a method wherein the absorbent paper product is selected from the group consisting of facial tissue, toilet tissue (Page 2, line 42 - 44), paper towel, napkin, and baby wipe products and wherein receiving includes receiving from the consumer a graphic design comprising a photographic image (Page 2, lines 42 – 44). Moreover and regarding claim 21, Direct Marketing teaches a system wherein said information includes information specifying a graphic design desired by the consumer, and wherein the production machine includes a printer for printing the graphic design on the absorbent paper product desired by the consumer (Page 2, lines 42 – 44).

However, Direct Marketing does specifically disclose and teach a method and system comprising the supplier - identifying a first feature of the absorbent product wherein the first feature includes a plurality of first options; identifying a second feature of the absorbent product, wherein the second feature includes a plurality of second options, wherein the second feature is different from the first feature and wherein each of the plurality of second options is different from any of the plurality of first options; providing to the consumer a first list of the first options for (a) the first feature of the absorbent paper product ; providing to the consumer a second list of the second 1 options for (a) the second feature of the absorbent paper product; receiving from the consumer a selection of one of the first options from the first list, a selection of one of the second options from the second list, and a purchase order for a particular absorbent paper product having the first and second options selected by the consumer; and delivering to the consumer the particular absorbent paper product having the first and second options selected by the consumer. Nor does Direct Marketing system and method include a production machine to produce the product as desired by the consumer including a graphic design - as well as a packaging capability.

On the other hand, Forseth discloses and teaches a method and system identifying a first feature of the absorbent product wherein the first feature includes a plurality of first options (see at least Page 12, Para 0137); identifying a second feature of the absorbent product, wherein the second feature includes a plurality of second options, wherein the second feature is different from the first feature and wherein each of the plurality of

second options is different from any of the plurality of first options (see at least Page 12, Para 0137); providing to the consumer a first list of the first options for (a) the first feature of the absorbent paper product (see at least Page 12, Para 0137 and Figures 9 – 11a); providing to the consumer a second list of the second options for (a) the second feature of the absorbent paper product (see at least Page 12, Para 0137 and Figures 9 – 11a); receiving from the consumer a selection of one of the first options from the first list, a selection of one of the second options from the second list, and a purchase order for a particular absorbent paper product having the first and second options selected by the consumer (see at least Page 12, Para 0132 and Figure 17); and delivering to the consumer the particular absorbent paper product having the first and second options selected by the consumer (Page 8, Para 0102 and Page 13, Para 0140) – as well as the method and system including a production machine to produce the product as desired by the consumer (see at least Page 8, Para 0101 and Figures 1 and 2a) including a graphic design on the packaging (see at least Figure 16 and 23c) via a communications network (see at least Figure 1). Moreover:

regarding claim 2 and related claims 13, 35 - 39, Forseth teaches a method wherein the first feature and the second feature are selected from the group consisting of product count, product style, product color (Page 3, Para 0059), product scent, product graphic design, product packaging style, product packaging color, and product packaging graphic design (Figure 16).

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regarding claim 5, Forseth teaches a method, wherein the absorbent paper product is a facial tissue product, and wherein the first feature and the second feature are selected from the group consisting of tissue count, tissue style, tissue color (Page 5, Para 0075), tissue scent, tissue graphic design, tissue packaging style (Figure 23c), tissue packaging color, and tissue packaging graphic design.

regarding Claim 6 and related claim 15, Forseth teaches a method, wherein the providing and the receiving are performed over a communications network (Page 9, Para 0108 and Figure 1).

regarding claim 7 and related claims 16 and 23, Forseth teaches a method and system, wherein the communications network is a computer network or a telephony network (Page 9, Para 0108 and Figures 1 and 2).

regarding claim 10, Forseth teaches a method, further comprising producing, in response to the receiving, a particular facial tissue product having the first and, second options selected by the consumer (see at least Figures 1, 2 and 15).

regarding claim 18, Forseth teaches a system, further comprising a computer server operatively connected to the production machine and the communications network, wherein the computer server is configured to receive said information from the consumer via the communications network, and to provide said information to the

production machine (See at least Figures 1 and 2) and (19) wherein the production machine is configured to automatically produce the absorbent paper product desired by the consumer in response to receiving said information from the computer server (Abstract and Figures 1 and 2) – as well as (20) wherein the production machine includes a packager configured to automatically package the absorbent paper product desired by the consumer (Figures 1 and 23c).

regarding claim 25, Forseth teaches a method wherein the communications network is a computer network, and wherein receiving includes receiving said information from the consumer over the computer network via a computer server (Figures 1 and 2).

regarding claim 26, Forseth teaches a method, wherein the communications network is a telephony network, and wherein receiving includes receiving said information from the consumer over the telephony network via a telephone attendant (Pages 6 and 7, Para 0086) and (27) wherein said telephone attendant is an automated attendant (Pages 6 and 7, Para 0086).

regarding claim 29, Forseth teaches a method wherein the absorbent paper product is a facial tissue product including facial tissues and packaging for the facial tissues, and wherein incorporating includes applying at least a portion of the graphic design received from the consumer to the facial tissues or the packaging for the facial tissues (Figures 1, 2, 16 and 23c).

regarding claim 31, Forseth teaches a method wherein receiving includes receiving from the consumer a graphic design comprising text (Figure 16).

regarding claim 33, Forseth teaches a method, wherein providing includes providing the custom absorbent paper product only to said consumer (Abstract and Figures 1 and 2).

regarding claim 40, Forseth teaches a method, further comprising: identifying a plurality of different features of the absorbent paper product selected from product count, product and product graphic design, style, product color, product scent each having at least one option; receiving from the consumer an identification of a selected option of the plurality of different features and a purchase order for a custom absorbent paper product embodying the selected option of the plurality of different features; to incorporating the selected option identified by the consumer into an absorbent paper product to thereby produce the custom absorbent paper product having the selected option ordered by the consumer; and providing the custom absorbent paper product including the selected option and having the packaging including the selected graphic design to the consumer (see at least Abstract and Figures 1 – 23c).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Direct Marketing with the method and system of Forseth to enable a method and system wherein the absorbent paper product is selected from the group consisting of facial tissue, toilet tissue, paper towel,

napkin, and baby wipe products and wherein receiving includes receiving from the consumer a graphic design comprising a photographic image and wherein said information includes information specifying a graphic design desired by the consumer, and wherein the production machine includes a printer for printing the graphic design on the absorbent paper product desired by the consumer and; the consumer identifying a first feature of the absorbent product wherein the first feature includes a plurality of first options; identifying a second feature of the absorbent product, wherein the second feature includes a plurality of second options, wherein the second feature is different from the first feature and wherein each of the plurality of second options is different from any of the plurality of first options; providing to the consumer a first list of the first options for (a) the first feature of the absorbent paper product ; providing to the consumer a second list of the second 1options for (a] the second feature of the absorbent paper product; receiving from the consumer a selection of. one of the first options from the first list, a selection of one of the second options from the second list, and a purchase order- for a particular absorbent paper product having the first and second options selected by the consumer; and delivering to the consumer the particular absorbent paper product having the first and second options selected by the consumer; and includes a production machine to produce the product as desired by the consumer including a graphic design - as well as a packaging capability. In that regard, the consumer will have a method and system that provides an online site which incorporates all facets of a transaction for selecting, purchasing, producing and delivery of an absorbent paper product from their home and thereby allow the consumer all

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theses functions without leaving their home – saving the consumer time and cost associated with on site shopping at a store or mall, which will increase the probability that they will be more satisfied as well increasing the probability that they will shop at the site in the future.

Claims 3, 9, 14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Direct Marketing and Forseth as applied to claims 1, 8, 11 and 18 above and further in view of Wilmott (US Patent Application Publication 2002/0082745).

The combination of Direct Marketing and Forseth disclose and teach substantially all the limitations of the applicant's invention.

However, the combination of Direct Marketing and Forseth do not specifically disclose and teach wherein a product feature includes scent and unscented; and wherein the first options for the product scent include unscented and wherein the production machine includes a fragrancier for applying a scent - as well as the method and system being available via a kiosk.

Regarding claim 3, Wilmott teaches a method wherein the first feature is product scent, and wherein the first options for the product scent include unscented (see at least Page 4, Para 0047).

Regarding claim 9, Wilmott teaches a method wherein providing includes providing the consumer with a list of scent options for the facial tissue product, and wherein receiving includes receiving from the consumer a selection of one of the scent options (Page 4, Para 0047).

Regarding claim 14, Wilmott teaches a method wherein collecting includes collecting the information from the consumer via a kiosk (Page 1, Para 0005).

Regarding claim 22, Wilmott teaches a system wherein said information includes information specifying a scent desired by the consumer, and wherein the production machine includes a fragrancier for applying the scent to the absorbent paper product desired by the consumer (Page 4, Para 0047).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Direct Marketing and Forseth with the method and system of Wilmott to enable a product feature to include scent and unscented as well as wherein the first options for the product scent include unscented and wherein the production machine includes a fragrancier for applying a scent as well as the method and system being available via a kiosk – in order to provide the consumer with more optional features and additional access places other than the home and thereby

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increasing their satisfaction as well increasing the probability of additional sales of absorbent paper products.

Claims 4, 8 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Direct Marketing and Forseth as applied to claims 2, 7 and 29 above, and further in view of Phillips et al (US Patent 6,186,553 B1).

The combination of Direct Marketing and Forseth disclose and teach substantially all the limitations of the applicant's invention. Moreover, Direct Marketing teaches the capability for the consumer to have multiple choices regarding graphics for printing on the tissue paper and Forseth teaches the capability for the consumer to have multiple choices regarding printing of graphics on the packages.

However, the combination of Direct Marketing and Forseth do not specifically disclose and teach wherein the first feature is product packaging graphic design, and wherein the first options for the product packaging graphic design include a predefined graphic design, no graphic design, and a graphic design supplied by the consumer as well as printing on the absorbent tissue and package.

On the other hand and regarding claim 4, Phillips teaches a method wherein the first feature is product packaging graphic design, and wherein the first options for the

product packaging graphic design include a predefined graphic design, no graphic design, and a graphic design supplied by the consumer (Col 6, lines 35 – 51).

Regarding claim 8, Phillips teaches a method wherein the absorbent paper product is a facial tissue product, wherein the first feature is tissue graphic design, and wherein the second feature is tissue packaging graphic design (Col 2, lines 30 – 51).

Regarding claim 30, Phillips teaches a method wherein receiving includes receiving a first graphic design and a second graphic design from the consumer, and wherein incorporating includes printing the first graphic design on the facial tissues and printing the second graphic design on the packaging for the facial tissues (Col 2, lines 30 - 51 and Col 7, lines 29 – 30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Direct Marketing and Forseth with the method and system of Phillips to enable wherein the first feature is product packaging graphic design, and wherein the first options for the product packaging graphic design include a predefined graphic design, no graphic design, and a graphic design supplied by the consumer and; wherein the absorbent paper product is a facial tissue product, wherein the first feature is tissue graphic design, and wherein the second feature is tissue packaging graphic design – as well as wherein receiving includes receiving a first graphic design and a second graphic design from the consumer, and wherein

incorporating includes printing the first graphic design on the facial tissues and printing the second graphic design on the packaging for the facial tissues. With this combination of methods and systems, the consumer will have ability to choose multiple graphic designs for the absorbent paper product and the packaging – as well as having these printed on the product and package too. In that regard, the consumer's satisfaction level will be increased and the probability that they will return for further shopping to tailor these products and packages for friends or their special occasion will be significantly increased.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7658 for regular communications and 703.308.3687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER
March 21, 2003


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